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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,695	10/23/2003	Niles Clark	144PA0102	6634
26882	7590	09/20/2006	EXAMINER HUYNH, KHOA D	
ROBERT R. WATERS, ESQ. WATERS LAW OFFICE, PLLC 633 SEVENTH STREET HUNTINGTON, WV 25701			ART UNIT 3751	PAPER NUMBER

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/691,695	CLARK, NILES	
	Examiner Khoa D. Huynh	Art Unit 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 July 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-41 is/are pending in the application.  
 4a) Of the above claim(s) 6,7,9-12,18-26,28-38 and 41 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-5,8,13-17,27,39 and 40 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 10/23/03; 01/23/06; 7/17/06 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Election/Restrictions***

1. Applicant's election of Group I and Species I (as depicted in Fig. 1) in the reply filed on 02/24/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 1-5, 8, 13-17, 27, 39 and 40 are deemed to read on the elected Species I. Thus, claims 6, 7, 9-12, 18-26, 28-38 and 41 have been withdrawn from further consideration as being drawn to the non-elected inventions.

### ***Drawings***

2. The drawings, especially Figure 14, were received on 01/23/2006. These drawings are disapproved because they introduce new matters which are not supported in the original specification. For example, the restrain structures around the neck (shown in Figure 14) include new matters that were not described in the original disclosure. Even though applicant argues that such "restrain structures" (60) around the neck of medicine vial (62) as shown in Figure 4, such assertion is accurate since (a) the restrain structures as shown in Figure 14 are not the same as the restrain structures (60) as show in Figure 4, and (b) the restrain structures of elected Species I (as depicted in Fig. 1) are not the same as the restrain structures (60) as show in Figure 4 since Figure 4 shows a different embodiment than that of Figure 1.

3. The drawings, especially amended Figure 1 and new Figure 13, were received on 07/17/2006. These drawings are disapproved because they introduce new matters

which are not supported in the original specification. For example, retainers 20 (shown in element 18 of Fig. 1) and 20b (show in element 18b of Fig. 1) are different than that of the retainers included in the original disclosure. Therefore, the amended Figure 1 contains new structures which were not included in the original specification. The restrain structures around the neck (shown in new Figure 13) are different than that of the retainers (depicted in the elected Figure 1) included in the original disclosure. Therefore, the new Figure 13 contains new structures which were not included in the original specification. In addition, the structures of the alternative guides (shown in amended Figure 1 and new Figure 13) have new matters that were not previously disclosed.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5, 8, 9, 13-17, 27, 39 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is unclear how "one interchangeable syringe guide" could be "interchangeable with each other" as recited in claim 1. Since claim 1 does not clearly set forth the metes and bounds of the patent protection desired, the scope of the claim is unascertainable. Claims 2-5, 8, 9, 13-17, 27, 39 and 40 depend on claim 1 and are likewise indefinite.

Also the recitation "said interchangeable syringe guides" lack antecedent basis and therefore, render claim 1 indefinite. Claims 2-5, 8, 9, 13-17, 27, 39 and 40 depend on claim 1 and are likewise indefinite.

Regarding claim 3, the recitation "said interchangeable syringe guides" lack antecedent basis and therefore, render claim 3 indefinite. Claims 39 and 40 depend on claim 3 and are likewise indefinite.

Regarding claim 4, the phrase "may fit" renders the claim indefinite because the resulting claim does not clearly set forth the metes and bounds of

the patent protection desired. Claims 5 and 8 depend on claim 4 and are likewise indefinite.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 8, 13, 14, 27 and 40, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Tetreault (5247972).

Regarding claim 1 (construe to include one interchangeable syringe guide), the Tetreault reference discloses an apparatus for filling a syringe from a medicine bottle or vial (Fig. 3). The apparatus includes a means for holding (at 10) a medicine vial (at 50) and an interchangeable syringe guide (at 20) operatively associated with the means for holding. The Tetreault reference also discloses that the means for holding is made to accommodate various sized interchangeable syringe guides (col. 3, lines 1-2) for accommodating various sized syringes and, inherently, different types (plastic-made and/or glass-made) of syringes (col. 4, lines 27-28).

Regarding claim 2, the Tetreault means for holding is inherently capable of holding different sizes, i.e. long or short medicine vials depending on required filling amount.

Regarding claim 3, the guide (at 20) includes a means for retaining (at 19,24) the syringe when the plunger is withdrawn to fill the syringe.

Regarding claim 4, as schematically shown in Figure 2, the means for holding (at 10) includes a cavity (the inner space of element 10 extending from the first end 11 to the second end 12) in communication with the medicine vial. The cavity has an open side (at 12).

Regarding claim 5, the guide (at 20) is made of a clear plastic material to allow the user to view of syringe barrel (col. 3, lines 40-42).

Regarding claim 8, the guide (at 20) includes a longitudinal aperture (at 27) for insertion of the syringe and thereby guiding the syringe to the seal in the medical vial (Fig. 3).

Regarding claims 13 and 14, the Tetreault reference also includes a cover or lid (14) operatively associated with the means for holding the bottle or vial. The cover or lid (14) is a magnifying lens which has a magnifying feature to increase the visibility of the markings of the syringe.

Regarding claim 27, the method as claimed would inherent during the normal use and operation of the Tetreault apparatus.

Regarding claim 40, the means for retaining (at 19,24) the syringe engages the edge (Figure 3 shows edge of portion 63) of the open end of the barrel of the syringe.

8. Claims 1-5, 8, 13, 16, 17, 27 and 39, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Larrabee (3993063).

Regarding claim 1 (construe to include one interchangeable syringe guide), the Larrabee reference discloses an apparatus for filling a syringe from a medicine bottle or vial (Fig. 3). The apparatus includes a means for holding (at 10,18) a medicine vial (at 14) and an interchangeable syringe guide (at 44) operatively associated with the means for holding. The interchangeable syringe guides is capable of accommodating various types, i.e. plastic-type, metal-type or glass-type syringes and sizes of the syringes.

Regarding claim 2, the Larrabee means for holding is inherently capable of holding different sizes, i.e. long or short medicine vials depending on required filling amount.

Regarding claim 3, the guide (at 10) includes a means for retaining (at 46,50) the syringe when the plunger is withdrawn to fill the syringe.

Regarding claim 4, as schematically shown in Figure 2, the means for holding (at 10,18) includes a cavity (the inner space of element 10) in communication with the medicine vial. The cavity has an open side (where element 12 is insert through as shown in Figure 1).

Regarding claim 5, the guide (at 44) is made of a lead-glass material to allow observation of the amount of material in the syringe barrel (col. 3, lines 60-63).

Regarding claim 8, the guide (at 44) includes a longitudinal aperture for insertion of the syringe and thereby guiding the syringe to the seal in the medical vial (Fig. 3).

Regarding claim 13, the Larrabee reference also includes a cover or lid (12,34) operatively associated with the means for holding the bottle or vial.

Regarding claims 16 and 17, the cover or lid (12,34) assists in retaining the vial (14) and the syringe located in the guide.

Regarding claim 27, the method as claimed would inherent during the normal use and operation of the Larrabee apparatus.

Regarding claim 39, the means for retaining (at 46,50) the syringe engages the tabs (48) of the open end of the barrel of the syringe.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Larrabee (as discussed supra) in view of Tetreault (5247972).

The Larrabee reference DIFFERS in that the lid does not specifically have a magnifying feature as claimed. Attention, however, is directed to the Tetreault reference which discloses an apparatus for filling a syringe from a medicine bottle or vial (Fig. 3). The apparatus includes a cover or lid (14) operatively associated with the means for holding the bottle or vial. The cover or lid (14) is a magnifying lens which has a magnifying feature to increase the visibility of the markings of the syringe. Therefore, it would have been obvious to one of

ordinary skill in the art at the time the invention was made to have modified the Larrabee lid by employing a magnifying feature, in view of the teaching of Tetreault, in order to accurately observe the amount of material in the vial.

***Response to Amendment***

11. The amendment filed 07/17/2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the structures of elements 18b and 20 as shown in Figure 13; the restrain structures around the neck as shown in Figure 14; and the structures of the alternative embodiment as shown in amended Figure 1). Applicant is required to cancel the new matter in the reply to this Office Action.

***Response to Arguments***

12. Applicant's arguments filed on 07/17/2006 with respect to the pending claims have been fully considered. However, they are deemed not persuasive.

Applicant asserts that the Tetreault reference does not teach the one interchangeable syringe guide and means for holding a medicine vial as claimed. See Remarks section, pages 24-25. The examiner disagrees.

As stated in the above rejection, the Tetreault reference does disclose an apparatus for filling a syringe from a medicine bottle or vial. The apparatus includes a means for holding a medicine vial and an interchangeable syringe guide operatively associated with the means for holding. The Tetreault reference also discloses that the

means for holding is made to accommodate various sized interchangeable syringe guides (col. 3, lines 1-2) for accommodating various sized syringes (col. 4, lines 27-28). Therefore, the Tetreault reference does anticipate applicant's invention as claimed since "each and every element" as set forth in the claim is found.

Applicant also asserts that the Larrabee reference does not teach an interchangeable syringe guides as claimed. See Remarks section, pages 26-27. The examiner disagrees.

As stated in the above rejection, the Larrabee reference does disclose an apparatus for filling a syringe from a medicine bottle or vial (Fig. 3). The apparatus includes an interchangeable syringe guide operatively associated with the means for holding. The interchangeable syringe guides is inherently capable of accommodating various types of syringe barrel (40) that are made of plastic, metal or glass material. Even though the Larrabee reference does not specifically disclose that the interchangeable syringe guide is able to "handle different sizes of syringes" (remarks section, page 16), such issue is not germane since claim 1 calls for "different sizes or types of syringes". Therefore, the Larrabee reference does anticipate applicant's invention as claimed since "each and every element" as set forth in the claim is found.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khoa D. Huynh whose telephone number is (571) 272-4888. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Khoa D. Huynh  
Primary Examiner  
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09/16/2006